

Applicant: Isabelle Mansuy and Eric R. Kandel
U.S. Serial No.: 10/091,714
Filed: March 5, 2002
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REMARKS

Claims 1-34 are pending in the subject application with claims 11-20 and 31-34 withdrawn from consideration. Applicants have hereinabove canceled claims 3, 7, 11-20, 24, 28 and 31-34 without disclaimer or prejudice to applicants' right to pursue the subject matter of these claims in the future. In addition, applicants have amended claims 1, 4, 5, 8, 9, 21, 25, 26, 29 and 30. Applicants maintain that the amendments to the claims raise no issue of new matter. Support for the amendments to claim 1 may be found in the specification at, *inter alia*, page 15, lines 14-21; page 15, line 26; page 16, line 3; and page 12, lines 1 to 10. Support for the amendments to claims 4 and 8 may be found in the specification at, *inter alia*, page 17, lines 9-11. Support for the amendments to claim 8 may be found in the specification at, *inter alia*, page 15, lines 4 to 8. Support for the amendments to claim 21 may be found in the specification at, *inter alia*, page 17, lines 20-28; and page 12, lines 1 to 10. Support for the amendments to claims 25, 26, 27 and 29 may be found in original claims 25, 26, 27 and 29 respectively. Accordingly, applicants respectfully request entry of this Amendment. Upon entry of this Amendment, claims 1, 2, 4-6, 8-10, 21-23, 25-27, 29 and 30 will be pending and under examination

Oath or Declaration

In the May 4, 2005 Office Action, the Examiner stated that the filed Declaration is defective in that the Post Office address of Eric Kandel is omitted.

In response, applicants attach hereto as Exhibit A a supplemental Declaration in accordance with 37 C.F.R. 1.67(a).

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Claim Objections

The Examiner objected to claims 1-10 because the subject matter of these claims allegedly goes beyond the elected subject matter characteristic of a transgene in both germline and somatic cells. Claims 3 and 7 have been cancelled, rendering the objection thereto moot.

In response to the objection to claims 1, 2, 4-6 and 8-10, but without conceding the correctness thereof, applicants note that amended claim 1 (on which claims 2, 4-6 and 8-10 depend) contains language that addresses the Examiner's concerns. Applicants therefore respectfully request that the Examiner reconsider and withdraw this objection.

Claims Rejected under 35 U.S.C. §101

The Examiner rejected claims 21-30 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants note that claims 24 and 28 are cancelled, rendering the Examiner's rejection thereof moot.

In response to the rejection of claims 21-23, 25-27, 29 and 30, but without conceding the correctness thereof, applicants note that amended claim 21, and its dependent claims, do not encompass human beings.

Claims Rejected under 35 U.S.C. §112, Enablement

The Examiner rejected claims 1-10 and 21-30 as allegedly failing to comply with the enablement requirement. The Examiner stated that the claims are directed to a transgenic nonhuman mammal

comprising a transgene providing for regulated expression of a heterologous nucleic acid sequence encoding a protein. The Examiner stated that the specification fails to provide an enabling disclosure for the claimed transgenic mammal because the use of a transgenic mammal is dependent on the particular phenotype of the animal, which is dependent on the particular transgene being expressed in the animal, as well as a host of other factors. The Examiner further stated that the specification does not disclose the phenotype of any transgenic animal having a genetic modification as recited in the claims. Applicants note that claims 3, 7, 24 and 28 have been cancelled, rendering the Examiner's rejection thereof moot.

In response to the rejection of claims 1, 2, 4-6, 8-10, 20-23, 25-27, 29 and 30, applicants respectfully traverse. Applicants note that amended independent claims 1 and 21 recite both the specific protein encoded by the second heterologous nucleic acid as well as a phenotype of the claimed transgenic mammals. Furthermore, applicants note that the claimed subject matter is exemplified by a working example in the specification (see, e.g., Figs. 1A, 1C and 1D).

Furthermore, applicants note, as stated at page 12, first paragraph that "[t]he present invention provides a transgenic nonhuman mammal in which the expression of a calcineurin inhibitor is spatially restricted to the forebrain and temporally regulated by the addition of doxycycline. As demonstrated herein, the transient expression of a calcineurin inhibitor in a mouse using the instant methods results in enhanced learning and memory as measured in behavioral tests, as well as increased long-term potentiation, as measured in hippocampal neurons. Thus, the transgenic mammals, compositions, and methods of the instant invention may be used to specifically evaluate the potential

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adverse effects of particular agents on learning and memory. As such, the instant invention provides an important addition to current methods for the assessment neurotoxicity."

Accordingly, applicants maintain that the claimed subject matter is enabled by the specification, and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

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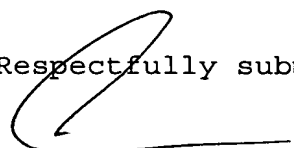
Summary

Applicants maintain that the pending claims are in condition for allowance, and respectfully request allowance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee, other than the enclosed \$225.00 fee for a two month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any other fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
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- 10/4/02
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